

### **Remarks**

Claims 1-19 are pending. No new matter is added. Examination of the pending claims is respectfully requested.

### **Pending Claims**

As noted above, claims 1-19 are pending. This is indicated correctly in the Office Action Summary (PTO-326) that is part of Paper 10. Only a single amendment to Claim 6 has been made, to remove a multiple dependency from this claim in order to reduce the filing fee. All other claims are in the original form as submitted with the application on July 27, 2001.

However, the Office action asserts (see page 2, paragraph 1) that claims 1, 11, 12, 14-19 and 20-29 were added by amendment dated July 21, 1999, and claim 10 was amended on July 2, 1999. Applicants suggest that these statements are in error as the present application was not pending in 1999. The Office action also asserts (see page 2, paragraph 1) that claims 1, 3, 5-12 and 14-29 are pending. However, as indicated in the Office action summary, claims 20-29 do not exist in the present application. Thus, Applicants request that the Examiner review the file of the present application to ensure that amendments from another application have not been inserted into the present prosecution history.

### **Restriction Requirement**

The Office action notes that during the initial examination of this application, no restriction requirement was asserted, and a search of the prior art was made for all of the originally filed claims. The Office action further states that "upon further updated searches in response to the Applicant's amendments to the originally filed claims, and upon further consideration of the prior art, all presently pending claims are now subjected to a restriction requirement..." As reflected in the above listing of claims, and as discussed above, NO substantive amendments of the claims have been made. Thus, Applicants cannot understand how any of their actions could necessitate a restriction requirement. The Examiner is requested

to review the file of the present application to ensure that amendments from an unrelated application have not been inadvertently inserted into the present case.

The MPEP clearly states (see MPEP 803, second paragraph):

If the search of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. [MPEP 803, emphasis supplied]

The Office action states that initial examination and complete searching of the prior art has already been performed (see the Office action at page 2, second paragraph, lines 8-10). Indeed, not only was the initial search performed, but updated searches were also performed and the prior art was considered (see the Office action at page 2, lines 10-11). There is clearly no support for the statement that “the search would constitute a burden,” and a *prima facie* case has not been established in support of the restriction requirement. On this basis, reconsideration and withdrawal of the restriction requirement is respectfully requested. If the restriction requirement is maintained, Applicants reserve the right to petition the restriction requirement on this basis.

However, as an election must be made in response to the restriction requirement, Applicants elect Group I (claims 1-11 drawn to mutant viruses and a process of using these viruses), with traverse. As noted above, based on the admissions in the Office action, it is clearly not an undue burden on the Examiner to search the subject matter of Group I with the subject matter of Groups II-IV.

As Group I has been elected, the Office action requires further elections with regard to Claim 7, 8, and 9. The Office action notes that claim 7 is generic to a plurality of distinct species, gH, gB, gL, ICP4, ICP8 and ICP27. Applicants elect gH, with traverse.

Applicants note that if a generic claim is found to be allowable and an election of a single species has been made, the Applicants are entitled to consideration of the claims to additional species which are written in dependent form or otherwise include all of the limitations of the generic claim (see The MPEP 809.02 (a)). Applicants intend to pursue all of the species

encompassed by the generic claim. Applicants also note that based on the statements in the Office action, it is the Applicants' understanding that the subject matter of the original claims, including all of these species, has already been searched. Thus, Applicants fail to understand the requirement for the election of species, and respectfully request that this requirement be withdrawn.

With regard to claims 8 and 9, the Office action requires election of one of the required species "GM-CSF, IL-2, IL-12, PX40, PX40L (gp34), and CD40L." In this response, Applicants have assumed that these species are GM-CSF, IL-2, IL-12, OX40, OX40L and CD40L, as recited in claim 9. With regard to claim 9, Applicants provisionally elect the species of GM-CSF, with traverse.

Once again, the Applicants note that if a generic claim is found to be allowable and an election of a single species has been made, the Applicants are entitled to consideration of the claims to additional species which are written in dependent form or otherwise include all of the limitations of the generic claim (see The MPEP 809.02 (a)). As discussed above, based on the statements in the Office action, it is the Applicants' understanding that all of the subject matter of the original claims, including all of these species, has already been searched. Thus, Applicants fail to understand the requirement for the election of species, and respectfully request that this requirement be withdrawn. Applicants intend to pursue all of the species encompassed by the generic claim.

With regard to a requirement of an election of species for claim 8, Applicants could not find the species "GM-CSF, IL-2, IL-12, OX40, OX40L (gp34), and CD40L" listed in claim 8. Thus, at the present time, Applicants do not believe they can be required to elect one of these species for claim 8. If a requirement for an election of species is being asserted for claim 8, Applicants respectfully request further written delineation of the requirement.

In the unlikely event that the restriction requirement is maintained, and the requirements for election of species are maintained, Applicants intend to submit a Petition to the Commissioner to request that the restriction requirement and the requirement for the election of species be withdrawn.


**Conclusion**

If any matters remain to be addressed before all of the pending claims are examined, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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By

  
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